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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Applicant: Plow	)	Art Unit: 3622
	)	
Serial No.: 09/922,182	)	Examiner: Myhre
	)	
Filed: August 2, 2001	)	STL9-2000-0035-US1
	)	
For: SYSTEM, METHOD, AND COMPUTER PROGRAM	)	August 10, 2007
PRODUCT FOR STORING INTERNET	)	750 B STREET, Suite 3120
ADVERTISEMENTS AT A USER COMPUTER	)	San Diego, CA 92101
	)	

**APPEAL BRIEF**

Commissioner of Patents and Trademarks  
Washington, DC 20231

Dear Sir:

This brief is submitted under 35 U.S.C. §134 and is in accordance with 37 C.F.R. Parts 1, 5, 10, 11, and 41, effective September 13, 2004 and published at 69 Fed. Reg. 155 (August 2004). This brief is further to Appellant's Notice of Appeal filed herewith.

**Table of Contents**

<u>Section</u>	<u>Title</u>	<u>Page</u>
(1)	Real Party in Interest.....	2
(2)	Related Appeals/Interferences.....	2
(3)	Status of Claims.....	2
(4)	Status of Amendments.....	2
(5)	Summary of Claimed Subject Matter .....	2
(6)	Grounds of Rejection to be Reviewed.....	4
(7)	Argument.....	4
App.A Appealed Claims		
App.B Evidence Appendix		
App.C Related Proceedings Appendix		

1176-3.API

RECEIVED  
CENTRAL FAX CENTER

AUG 10 2007

CASE NO.: STL9-2000-0035-US1

Serial No.: 09/922,182

August 10, 2007

Page 2

PATENT

Filed: August 2, 2001

**(1) Real Party in Interest**

The real party in interest is IBM Corp.

**(2) Related Appeals/Interferences**

No other appeals or interferences exist which relate to the present application or appeal.

**(3) Status of Claims**

Claims 1-4, 6-11, and 13-19 are pending and finally rejected, which rejections are appealed, and Claims 5, 12, and 20-22 have been canceled.

**(4) Status of Amendments**

No amendments are outstanding.

**(5) Summary of Claimed Subject Matter**

As an initial matter, it is noted that according to the Patent Office, the concise explanations under this section are for Board convenience, and do not supersede what the claims actually state, 69 Fed. Reg. 155 (August 2004), see page 49976. Accordingly, nothing in this Section should be construed as an estoppel that limits the actual claim language.

Claim 1 sets forth a method for storing Internet advertisements at a user computer. The method includes receiving plural Internet advertisements at the user computer automatically without the user requesting them (block 32, figure 2, page 6 first few lines). The method also includes saving plural advertisements at

1176-3.API

CASE NO.: STL9-2000-0035-US1

Serial No.: 09/922,182

August 10, 2007

Page 3

PATENT

Filed: August 2, 2001

the user computer (block 40, figure 2, page 6, line 12), allowing a user to access saved advertisements in an advertising history window displaying Internet content composed of plural advertisements (block 44, figure 2, page 6, lines 13-16; figure 3), and allowing a user to filter previously displayed advertisements, so that only advertisements corresponding to one or more user selected attributes are eligible for display, page 7, lines 15-17. The saved advertisements include at least one link to a website and the method further includes recalling a user-selected saved advertisement, with the saved advertisement having at least one link to a website (page 2, first two lines), and accessing the website from the saved advertisement when the link is toggled (id.)

Claim 7 sets forth a system (10, figure 1, page 4) for saving at least one Internet advertisement at a user computer (12, id.). The system includes at least one Web server (22, id.) and at least one database (24, id.) connected to the server, with the database storing plural Internet advertisements. A user computer (id.) is connected to the server via an Internet connection, and the server transmits the Internet advertisements to the user computer while the user is engaged in activity other than requesting the advertisements (page 7, last paragraph). The user computer includes a program for saving at least one Internet advertisement (block 40, figure 2, page 6, lines 11 and 12), with the program displaying plural saved advertisements simultaneously in an advertisement window (figure 3) such that a user may select a saved advertisement from the window for display on the user computer (page 6, lines 15 and 16 and figure 3). The saved advertisements include at least one link to a website (page 2, lines 1 and 2) and the program further includes logic means for enabling a user to select a saved advertisement for display thereof, page 7, lines 15-17, and logic means for accessing the website from the saved advertisement when the link is toggled, id.

The reference numerals above are incorporated into this paragraph by reference. Claim 14 recites a computer program device (page 5, lines 7-13) that has a computer readable means having logic means for

1176-3.AFI

RECEIVED  
CENTRAL FAX CENTER

AUG 10 2007

PATENT

Filed: August 2, 2001

CASE NO.: STL9-2000-0035-US1

Serial No.: 09/922,182

August 10, 2007

Page 4

storing at least one Internet advertisement. Logic means (32, figure 2; page 6, line 1) receive plural Internet advertisements at a user computer. The advertisements are sent to the user computer automatically in response to a user request for information other than the advertisements, page 4, second paragraph. Logic means (40, figure 2; page 6, line 13) save advertisements at the user computer, and means (42, 44, figure 2; page 6, lines 13-16) are provided for allowing a user to select saved advertisements in an advertisement history window displaying Internet content composed only of advertisements (figure 3). Means (44, id.) enable a user to recall at least one user-selected advertisement, and means (page 7, last paragraph; computers 12, 18, with keyboards, figure 1, page 4) are provided for accessing the website from the saved advertisement when the advertisement is toggled.

(6) **Ground of Rejection to be Reviewed on Appeal**

Claims 1-4, 6-11, and 13-19 have been rejected under 35 U.S.C. §102 as being anticipated by Lemole et al., USPN 6,009,410.

(7) **Argument**

This is the second appeal brief in this case and the fourth set of references. It is past time either to allow the case or allow Appellant to have its day before the Board.

**Claim 1**

1. The rejection of Claim 1 fails to mention the limitation of an advertising history window displaying Internet content composed of plural advertisements, nor do any of the cited sections of the reference

1176-3A(1)

CASE NO.: STL9-2000-0035-US1  
Serial No.: 09/922,182  
August 10, 2007  
Page 5

PATENT  
Filed: August 2, 2001

mention one. The closest the rejection comes to alleging that the recited limitation is in the reference is in paragraph "c" on page 4 of the Office Action, alleging that col. 5, lines 23-27 of LeMole et al. teaches "accessing saved advertisements by the user on the display of the user computer", but that is not what is claimed. The rejection is ripe for reversal.

The latest rejection insists that the "HTML-formatted advertising page" of Lemole et al. meets the claim, page 5 of Office Action. First, no citation to Lemole et al. has been given to support this allegation. Second, a HTML-formatted advertising page, or even a "plurality of different composite pages" as alleged in the rejection, is not an advertising history window as claimed. It appears to be a pastiche of something but a pastiche of something is not the specific thing claimed.

Moreover, the relied-upon portion of LeMole et al. does not address advertisements that are saved *at the user computer* as claimed, but rather an "advertising page" on a server that subsequently can be accessed by the user computer, see col. 6, lines 20-45. The page dynamically changes at the server, col. 6, line 38, but in any case (1) nothing in the relied-upon section of LeMole et al. indicates that it is saved on the user computer, much less that it is displayed in its own advertising history window on the user computer. The examiner alleges without citation that the above pages are cached but this similarly does not meet the relevant limitation in the claim.

2. The rejection of Claim 1 fails to mention the limitation of allowing *a user* to filter previously displayed advertisements, so that only advertisements corresponding to one or more user selected attributes are eligible for display. The closest the rejection comes to alleging that the recited limitation is in the reference is in paragraph "d" on page 4 of the Office Action, alleging that col. 5, lines 16-22 of LeMole et al. teaches "filtering previously displayed advertisements to determine eligible advertisements", and the reason

1176-3API

CASE NO.: STL9-2000-0035-US1  
Serial No.: 09/922,182  
August 10, 2007  
Page 6

PATENT  
Filed: August 2, 2001

the Office Action studiously avoids alleging that the filtering is done by the user as claimed is because in LeMole et al., it isn't. The relied-upon portion of the reference makes clear that the "filtering" is done by the CAR server 111. The rejection is ripe for reversal.

This has been responded to by the game-playing that has characterized prosecution. The current Office Action actually takes the position in the middle of page 5 that because the CAR server 111 bases its selections on a user profile (step 306), and because this profile in some way is based on data a user entered at some point, then that is the same thing as allowing a user to filter the ads. This, of course, is fatuous. The CAR server, based on its own evaluation of the user's profile, makes the selections for the user. The user gets to filter nothing, in contrast to what Claim 1 says.

#### Claim 4

3. The rejection of Claim 4 alleges that figure 2 of LeMole et al. allows a user to scroll through the saved advertisements, pointing to the scroll bar shown in the figure. This is incorrect. Figure 2 shows a registration form used to select genres of advertisements, not saved advertisements themselves. The rejection of Claim 4 is further overcome.

This has been responded by an unsupported allegation that a scroll bar appears somewhere in Lemole et al. and that this scroll bar inherently allows a user to scroll through ads. Appellant cannot locate the scroll bar or the advertising history window in Lemole et al.

#### Claim 6

1176-3.AP1

RECEIVED  
CENTRAL FAX CENTER

AUG 10 2007

CASE NO.: STL9-2000-0035-US1

Serial No.: 09/922,182

August 10, 2007

Page 7

PATENT

Filed: August 2, 2001

4. The rejection of Claim 6 alleges that LeMole et al., figure 2 and col. 6, line 63-col. 7, line 35 teaches displaying and using back and forward buttons to navigate through the saved advertisements, but this is incorrect. As clarified above, figure 2 has nothing to do with saved advertisements, but only permits a user to register for certain genre of ads. The cited portions of the LeMole et al. specification discuss clicking on ads in the ad page at the server, not at the user computer. To the extent that the user is navigating through anything it through a live web page, not saved advertisements on the user computer. Other than yet another unsupported insistence that Lemole et al. teaches this, the examiner offers no meaningful rebuttal.

**Claim 7**

5. The Office Action does not bother to separately address independent Claim 7, which fatally dooms the blanket rejection because Claim 7 requires limitations not found in Claim 1. For example, Claim 7 requires that the server transmit the Internet advertisements to the user computer while the user is engaged in activity other than requesting the advertisements, but this limitation has not been discussed in the Office Action. The rejection of Claim 7 has been overcome.

**Remaining Claims**

6. The comments apply *mutatis mutandis* to the rejection of independent Claim 13.

**Section 112 Holding**

7. The examiner notes that he refuses to construe Claims 7-11 and 13-19 in accordance with the sixth paragraph of Section 112 because allegedly these claims fail to "pass" prongs 2 and 3 of the three-prong

1176-3 API

CASE NO.: STL9-2000-0035-US1

Serial No.: 09/922,182

August 10, 2007


Page 8

PATENT

Filed: August 2, 2001

test. These "prongs" are, respectively, that the claim not recite a structural limitation, and that structure is taught in the specification to support the claimed means-plus-function elements. The rejection descends into illogic, however, by alleging that the claims, in reciting "logic means", "thus eliminat[e] any kind of physical structure", Office Action, page 3, line 10 - an explicit avowal on the record that the second prong in fact is met. The allegation that the third prong is not met because the specification teaches that "the means for performing these functions [are] part of a computer program" likewise is illogical. Every computer performs functions encoded in software. Under the examiner's reasoning no computer claim could ever be expressed under the sixth paragraph of Section 112. In fact, almost the entire page 5 of the specification expressly teaches structure that is correlated to the claimed functions.

Respectfully submitted,

  
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CASE NO.: STL9-2000-0035-US1

Serial No.: 09/922,182

August 10, 2007

Page 9

PATENT

Filed: August 2, 2001

**APPENDIX A - APPEALED CLAIMS**

1. A method for storing Internet advertisements at a user computer, comprising the acts of:
  - receiving plural Internet advertisements at the user computer automatically without the user requesting them;
  - saving at least plural advertisements at the user computer;
  - allowing a user to access saved advertisements in an advertising history window displaying Internet content composed of plural advertisements;
  - allowing a user to filter previously displayed advertisements, so that only advertisements corresponding to one or more user selected attributes are eligible for display;
  - wherein the saved advertisements include at least one link to a website and the method further comprises:
    - recalling a user-selected saved advertisement, the saved advertisement having at least one link to a website; and
    - accessing the website from the saved advertisement when the link is toggled.
2. The method of Claim 1, wherein the advertisement includes a tag that is a Hypertext Markup Language (HTML) tag.
3. The method of Claim 1, further comprising the act of:
  - displaying a button; and
  - in response to the button being toggled, displaying the saved advertisement.

1176-3AP1

**CASE NO.: STL9-2000-0035-US1****Serial No.: 09/922,182****August 10, 2007****Page 10****PATENT****Filed: August 2, 2001**

4. The method of Claim 3, wherein plural advertisements are saved and the method further comprises:

allowing the user scroll through the saved advertisements.

6. The method of Claim 1, further comprising the acts of:

displaying a previous button in the advertising window;

displaying a next button in the advertising window; and

accessing saved advertisements when the previous button and next button are toggled.

7. A system for saving at least one Internet advertisement at a user computer comprising:

at least one Web server;

at least one database connected to the server, the database storing plural Internet advertisements; and

at least one user computer connected to the server via an Internet connection, the server transmitting the Internet advertisements to the user computer while the user is engaged in activity other than requesting the advertisements, the user computer including a program for saving at least one Internet advertisement, the program displaying plural saved advertisements simultaneously in an advertisement window such that a user may select a saved advertisement from the window for display on the user computer;

wherein the saved advertisements include at least one link to a website and the program further comprises:

11763.API

CASE NO.: STL9-2000-0035-US1  
Serial No.: 09/922,182  
August 10, 2007  
Page 11

PATENT  
Filed: August 2, 2001

logic means for enabling a user to select a saved advertisement for display thereof,  
the saved advertisement having at least one link to a website; and

logic means for accessing the website from the saved advertisement when the link is  
toggled.

8. The system of Claim 7, wherein the program includes:

logic means for receiving plural Internet advertisements; and

logic means for saving at least one advertisement at the user computer.

9. The system of Claim 7, wherein the advertisement a Hypertext Markup Language  
(HTML) tag.

10. The system of Claim 8, wherein the program further comprises:

logic means for displaying a button; and

logic means for displaying the saved advertisement in response to the button being  
toggled.

11. The system of Claim 10, wherein plural advertisements are saved and the program  
further comprises:

logic means for allowing the user scroll through the saved advertisements.

13. The system of Claim 8, wherein the program further comprises:

logic means for displaying a previous button;

logic means for displaying a next button; and

1176-3AF1

CASE NO.: STL9-2000-0035-US1

Serial No.: 09/922,182

August 10, 2007

Page 12

PATENT

Filed: August 2, 2001

logic means for accessing saved advertisements when the previous button and next button are toggled.

14. A computer program device, comprising:

a computer readable means having logic means for storing at least one Internet advertisement, comprising:

logic means for receiving plural Internet advertisements at a user computer, the advertisements being sent to the user computer automatically in response to a user request for information other than the advertisements;

logic means for saving advertisements at the user computer;

means for allowing a user to select saved advertisements in an advertisement history window displaying Internet content composed only of advertisements;

means for enabling a user to recall at least one user-selected advertisement; and

means for accessing the website from the saved advertisement when the advertisement is toggled.

15. The computer program device of Claim 14, wherein an advertisement includes a Hypertext Markup Language (HTML) tag.

16. The computer program device of Claim 14, wherein the computer readable means further comprises:

logic means for displaying a button; and

logic means for displaying the saved advertisement in response to the button being toggled.

1176-3-API

**CASE NO.: STL9-2000-0035-US1**  
**Serial No.: 09/922,182**  
**August 10, 2007**  
**Page 13**

**PATENT**  
**Filed: August 2, 2001**

17. The computer program device of Claim 16, wherein plural advertisements are saved and the computer readable means further comprises:

logic means for allowing the user scroll through the saved advertisements.

18. The computer program device of Claim 16, wherein the saved advertisements include at least one link to a website and the computer readable means further comprises:

logic means for receiving plural Internet advertisements, at least one advertisement including a tag; and

logic means for saving at least one advertisement at the user computer at least partially based on the tag.

19. The computer program device of Claim 14, wherein the computer readable means further comprises:

logic means for displaying a previous button;

logic means for displaying a next button; and

logic means for accessing saved advertisements when the previous button and next button are toggled.

1176-2-AP1

**CASE NO.: STL9-2000-0035-US1**  
**Serial No.: 09/922,182**  
**August 10, 2007**  
**Page 14**

**PATENT**  
**Filed: August 2, 2001**

**APPENDIX B - EVIDENCE**

None (this sheet made necessary by 69 Fed. Reg. 155 (August 2004), page 49978.)

1176-3 API

**CASE NO.: STL9-2000-0035-US1**  
**Serial No.: 09/922,182**  
**August 10, 2007**  
**Page 15**

**PATENT**  
**Filed: August 2, 2001**

**APPENDIX C - RELATED PROCEEDINGS**

None (this sheet made necessary by 69 Fed. Reg. 155 (August 2004), page 49978.)

1176-3 API